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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,316	01/18/2002	Alfred Thomas	2100/17	8018

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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 03/26/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/051,316

Applicant(s)

THOMAS ET AL. *on*

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-47,49-80,82-103 and 112-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 112 and 113 is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-22,36-47,49-55,57-80,82-88,90-103 and 114 is/are rejected.
- 7) ☒ Claim(s) 13,23-35,56 and 89 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION*****Withdrawal of Finality***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The examiner has modified the below claim rejections to provide an improved prior art rejection of the instant claims. This is not an attempt by the examiner to prolong prosecution of the instant application. However, it is an attempt to make the record as accurate and clear as possible.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-12, 15-21, 41, 44-47, 49-56, 58-72, 78-80, 82-88, 91-98, 100-101 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978).

Regarding claims 1, 41, 47, 49, 64, Moody teaches a method of operating a gaming machine, that comprises the steps of providing a first game of chance {1<sup>st</sup> hand} which concludes in a final outcome; providing a second game of chance {2<sup>nd</sup> hand} which has the potential on every play for achieving a prize award; placing a wager; operating said first game of chance; operating said second game of chance in conjunction with the first game of chance {both 1<sup>st</sup> and 2<sup>nd</sup> hand are played at the same

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time- concurrently- in Moody}; awarding any prize achieved in the second game of chance (abstract; Fig. 2-6). While Moody teaches the feature of prize awards, Moody lacks the explicit teaching of the prizes being non-monetary. In an analogous electronic slot gaming machine that includes slot games and simulated card games, Paulsen teaches the feature of prize awards that are only non-monetary (abstract; Fig. 1; col. 3, lines 27-30; col. 1, lines 33-39 and lines 50-57; col. 2, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the non-monetary prize feature, as taught by Paulsen, as the prize award feature in the second game of Moody to provide more desirable gaming opportunities for players that are more attracted to games with non-monetary prizes and for game operators in jurisdictions that might restrict the prizes to non-monetary prizes, according to the gaming rules of those jurisdiction.

Regarding claims 3-6, 58-61, Moody and Paulsen teach all the limitations of the claims as discussed above. Paulsen further teaches that the prizes could be tangible goods and services (col. 5, lines 23-32). Paulsen is silent regarding the explicit disclosure of point values. However, it is well known in the art to award players points values that are credits that can redeemed during a next play of the game or at various other times (in the form of tickets, vouchers, etc.). Further, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate prize points in Paulsen to further enhance the player's gaming experience.

Regarding claims 7-9, 12, 15-19, Moody and Paulsen teach all the limitations of the claims as discussed above. Moody further teaches a plurality of different card

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indicia {interpreted as prize indicia by the examiner because combinations of the card indicia determine the prize (payout) awarded to the player} for the second game of chance, a preset number of card indicia {five cards} being displayed in the course of the second game through a random selection, and said prize award is achieved through a predetermined association of the card indicia {prizes or payouts are awarded in Moody according to a predetermined combination of the card indicia} (abstract; col. 1, lines 52-65). Further, Paulsen teaches a plurality of non-monetary prize awards (abstract).

Regarding claims 10-11, 50-56, 65-71, Moody and Paulsen teach all the limitations of the claims as discussed above. Moody further teaches that the indicia of the first and second game of chance are displayed in a like number to each other {five indicia are displayed for both the 1<sup>st</sup> and 2<sup>nd</sup> hand}.

Regarding claims 20, 62, 72, Moody and Paulsen teach all the limitations of the claims as discussed above. While Moody teaches a third game (Fig. 20) {a third hand, #530}, Moody is silent regarding the explicit disclosure of this game as a bonus game. Moody also lacks the explicit disclosure of the bonus game being won as one of the prizes from the second game. However, the examiner asserts that bonus games are well known in the art. Further, it is well known in the art to "award" players with a bonus game for achieving certain ideal outcomes in a base game. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ these features in Moody and Paulsen to provide increased popularity for continued play of the gaming device; thereby providing increased profits to the gaming establishment.

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Regarding claims 21, 63, Moody and Paulsen teach all the limitations of the claims as discussed above. The references are silent regarding the use of a player tracking system. However, the examiner takes notice that it is well known in the art to employ player tracking systems as a means of tracking players and awarding valuable players {those that frequent the gaming establishment and/or spend large sums of money on the gaming machines}. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include player tracking in Moody and Paulsen as an incentive for a player to play the second game {second hand of Moody} to increase play at the gaming machine.

Regarding claims 44-46, Moody and Paulsen teach all the limitations of the claims as discussed above. Paulsen further teaches the delivery of coupons, vouchers or other entitlement papers for the prizes (col. 5, lines 28-32). Paulsen is silent regarding the use of a printer to deliver the coupons, etc. It is well known in gaming arts to print out slips with gaming credits for players to redeem at a cashier's station or other place within the gaming establishment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of a printer in Paulsen to provide an easy, convenient means for players to receive game credits.

Regarding claims 78-80, 82-88, 91-98, 100-101, 103, Moody and Paulsen teach all the limitations of the claims as explained in detail in reference to similar claims, above.

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Claims 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978), further in view of **Hughes-Baird et al** (6,468,156).

Regarding claim 102, Moody and Paulsen teach all the limitations of the claims as discussed above. The references are silent regarding a bonus payout table. However, in an analogous gaming device, Hughes-Baird teaches a bonus pay schedule (Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ a bonus pay schedule, as taught by Hughes-Baird in Moody and Paulsen to increase the player's chances of winning additional money thereby increasing play at the gaming device.

Claims 14, 36-39, 57, 73-77, 90, 99 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978), further in view of **Yoseloff et al** (6,311,976).

Regarding claims 14, 36-39, 57, 73-77, 90, 99, 114, Moody and Paulsen teach all the limitations of the claims as discussed above. While Moody and Paulsen teach slot gaming devices, the references lack the explicit disclosure of the devices having a reel display. In an analogous slot gaming device, Yoseloff teaches the use of reel slot machines in a video gaming environment (col. 1, lines 40-48). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include reels in Moody and Paulsen to make the game more realistic and exciting by simulating the reels of original, mechanical slot machines.

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Claims 22, 40 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978), further in view of **Meekins** et al (6,685,563).

Regarding claim 22, Moody and Paulsen teach all the limitations of the claim as discussed above. While Moody teaches the feature of placing a wager for a first and second game {1<sup>st</sup> and 2<sup>nd</sup> hands} (see abstract), Moody is silent regarding the feature of the wager for the second game being greater in value than the wager for the first game. In an analogous gaming device, Meekins teaches the feature of a greater threshold wager being required for the player to play a second game {bonus game} than that required to play the first game (col. 2, lines 4-10 and lines 41-50). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Meekins in the gaming devices of Moody and Paulsen to increase revenues to the casinos and wagering establishments.

Regarding claims 40 and 42, Moody and Paulsen teach all the limitations of the claims as discussed above. While Moody teaches the play of the first and second game with a wager for each, Moody is silent regarding play of the second game if the wager is of a preset amount. Meekins teaches this feature as discussed above. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Meekins in the gaming devices of Moody and Paulsen to increase revenues to the casinos and wagering establishments.

Regarding claim 43, Moody, Paulsen and Meekins teach all the limitations of the claims as discussed above. Paulsen further includes the use of a card to place a wager



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(Fig. 4B, #414e; col. 3, lines 19-21). It would have been obvious to a person of ordinary skill in the art at the time of the invention for further enhance Paulsen to include requiring the player to place a preset wager on the card to promote the use of a card as the means for wagering; this would decrease the amount of maintenance needed for the machine for refilling and unloading coins; thereby making it easier for the gaming establishment to maintain the machines. Further, the use of cards makes it more convenient for the establishment to provide player tracking and award comps to frequent players, which is a well known feature in the gaming art.

***Allowable Subject Matter***

Claims 112-113 are allowed.

Claims 13, 23-35, 56 and 89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for the indication of allowable subject matter can be found in the previous office action (paper #9, 12/3/03), which is incorporated herein by reference.

***Examiner's Response to Applicant's Remarks***

Applicant's arguments regarding the 102(e) rejection of claim 114 with the Yoseloff reference are now moot in light of the new claim rejections cited above. Applicant argues that Moody does not teach a non-monetary prize award. The examiner has cited Paulsen in combination with Moody, above to teach this feature. The examiner has further provided the additional references of Hughes-Baird and Meekins to further teach the instant claim limitations. The examiner has provided

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detailed explanations of her interpretation of the claim language, above. Therefore, applicant's arguments are now moot in light of the new claim rejections above. The examiner has withdrawn finality of the rejection in light of the new art rejections, above.

The examiner suggests that Applicant focus on the language of the claims indicated as allowable subject matter above. These claims provide a clearer teaching of the association of award indicia for the second game with each card indicia of the first game, as can be seen in Figures 1 and 2 of the instant application. These features provide a clear distinction from the prior art. The claims rejected above, are much broader and do not provide a clear distinction from the prior art.

***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

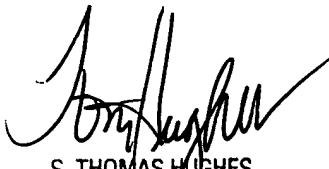
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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